

REMARKS

In this response, claims 1 and 3 have been amended. The amended claims are supported by the specification and no new matter has been added. Applicant respectfully submits that claim 1 has been amended to clarify preexisting claim limitations. Applicant submits that the applicant's specification as originally filed provides support for the amendments to claim 1, for example, at least at page 5, lines 9-15, and the originally filed claim 2. Claims 2 and 4 have been canceled. Newly presented claim 5 is supported by the specification as originally filed, e.g., at least at page 6, line 13 to page 7, line 12 and Figures 3-5. No new matter has been added. Therefore, claims 1, 3, and 5 are pending in the application.

Applicant respectfully requests reconsideration of this application as amended.

Objections to the Drawings

Figures 1-5 have been objected to for lacking of figure numbers. Figure 1 has been objected to for lacking of the legend -- Prior Art --. Applicant has enclosed herewith replacement sheets for Figures 1-5 and submits that the objections have been overcome.

Objections to the Specification

The specification has been objected to because paragraph two, page four, of the specification allegedly does not appear to belong. Applicant has amended the specification to delete this typographical error.

Objections to the Claims

Claims 1-4 stand objected to because they included reference characters which are not enclosed within parentheses. Applicant respectfully submits that claims 1 and 3 have been amended to show reference characters in parentheses, as suggested by the Examiner. Claims 2 and 4 have been canceled. Applicant respectfully requests that the objection to claims 1-4 be withdrawn.

Claim Rejections

Claims 1-4 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. Applicant respectfully submits that claim 1 has been amended to properly provide antecedent basis for the limitation “bottom rubber sole” in the claim. Claims 2 and 4 has been canceled. Given that claim 3 depends on claim 1, accordingly, applicant requests that the rejection of claims 1-4 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Claim 1 is rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,758,435 to Miyata (hereinafter “Miyata”).

Applicant respectfully requests withdrawal of this rejection because the cited reference fails to disclose each and every feature of the claim. In particular, Miyata does not disclose the feature of “diameters of the plurality of round-shaped seat holes (22) are gradually reduced from heel part to front part of the bottom rubber sole (20), and the metal balls (26) fixed in the plurality of round-shaped seat holes (22) are formed to be same sizes as the diameters of the plurality of round-shaped seat holes (22),” as recited in claim 1.

Miyata describes a training shoe that can apply a larger-than-normal load to strengthen leg muscles while maintaining good flexibility, cushioning properties and other necessary properties required for shoes. Even though Miyata describes a training shoe with a sole that is partitioned into a plurality of weight chambers, each chamber receiving weight containing metallic grains, the sizes of weight chambers and the sizes of weight containing metallic grains in Miyata are uniform. (Miyata, col. 2, lines 23-51, Figures 1-4C). Miyata does not disclose that the size of a weight chamber or a weight containing metallic grains can be changed along the length of a sole.

Therefore, applicant respectfully submits that claim 1 is patentable over Miyata. Accordingly, applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. § 102(b) be withdrawn.

Claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Japanese Patent Application No. 10165203 to Shimizu (hereinafter “Shimizu”) in view of Miyata.

Applicant respectfully requests withdrawal of these rejections because the combination of the cited references fails to teach or suggest all of the features of the claims. In particular, Shimizu and Miyata, either alone or in combination, fail to disclose

a plurality of round-shaped seat holes (22) formed in thickness direction of a bottom rubber sole (20) formed at the lower part of said cushion layer (30); and metal balls (26) to be fixed in the plurality of round-shaped seat holes (22), wherein diameters of the plurality of round-shaped seat holes (22) are gradually reduced from heel part to front part of the bottom rubber sole (20), and the metal balls (26) fixed in the plurality of round-shaped seat holes (22) are formed to be same sizes as the diameters of the plurality of round-shaped seat holes (22).

(Amended claim 1).

Shimizu describes a shoe with rectangular-shaped weights inserted in the bottom of the shoe. (Shimizu, Figures 1, 5, and 7). The Examiner recognizes that Shimizu “does not to disclose round seat holes or weights in the form of balls.” (Office Action, 3/13/2009, page 6). However, the Examiner states that

It would have been obvious to one of ordinary skill in the art at the time of the invention to have made the seat holes round and the weights balls as this would merely be a change in shape of the holes and weights. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. In re Dailey et al., 149 USPQ 47.

(Office Action, 03/13/2009, page 6) (emphasis added).

Applicant respectfully disagrees with the Examiner’s interpretation of the cited case with respect to claim 1. The court in *Dailey* held that the configuration of the claimed disposable plastic nursing container was a matter of choice with a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant. (In re Dailey, 357 F.2d 669 (CCPA 1966); MPEP § 2144.04 IV.B) (emphasis added).

In Shimizu, as shown in Figures 1 and 5, the rectangular-shaped weights added to the bottom of a shoe make the shoe less flexible and less elastic than the metal balls and round-shaped seat hole design, as disclosed in claim 1. Furthermore, the rectangular-shaped weights disclosed by Shimizu are likely to come off or damage the shoes when the shoes are bent during exercising, and in turn increase the risk of injury.

In contrast, the metal ball and round-shaped seat hole design as set forth in claim 1 is not merely “a change in form or shape” or “a matter of choice.” The design recited by claim 1 has the following significant and unexpected advantages. In the originally-filed specification, applicant states that “[i]t is an object of the present invention to provide health shoes by forming a metal ball on the bottom part of the shoes at the same time of

maintaining flexibility and elasticity of the shoes itself.” (Specification: page 3, lines 10-15, emphasis added). Applicant further states that “by fixing a metal ball 26 in the seat hole 22 formed at the bottom rubber sole 20 of the present invention, it is characterized in that the metal ball 26 does not easily fall off even when the bottom rubber sole 20 is twisted to the left, right, front or back.” (Specification: page 7, lines 13-15).

MPEP § 2144.04 states that “[i]f the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.” Because applicant has demonstrated the criticality of the features of metal ball fixed in the round-shaped seat holes at the bottom rubber sole of the shoe, accordingly, applicant respectfully submits that claim 1 is patentable over cited references.

In addition, it is respectfully submitted that one of ordinary skill in the art would not have reason nor be motivated to combine the cited references in the manner purported by the Office Action. Motivation to combine or modify the prior art is lacking when the prior art teaches away from the claimed combination. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994). Applicant respectfully submits that Miyata teaches away from the use of variable-size weight chambers and weights along the length of a shoe because Miyata discloses that the weight chambers are regularly arranged in his training shoe and the weights are buried uniformly inside the weight chambers. (Miyata, Abstract; Col. 2, line 63, emphasis added). Miyata provides the following reasons for his regularly arranged and uniformly buried weight design: “[s]ince the metallic grains or metallic pieces as weights are distributed uniformly over the entire area of the sole without impairing the resilience of the sole, the weight balance of the shoe is good.” (Miyata, Col. 1, lines 13-16). In other words,

Miyata teaches away from a non-uniform distribution of the weights. Therefore, one of ordinary skill in the art would not be motivated to combine Miyata with Shimizu.

Furthermore, “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990). Miyata is directed to a training shoe with a larger-than-normal load to strengthen leg muscles, and Miyata provides a solution using weight chambers filled with weights containing metallic grains in the outsole of his training shoe. Thus, one of ordinary skill in the art would not have reason nor be motivated to combine the teachings of Miyata and Shimizu since Miyata alone provides a solution to the stated problem. Applicant submits that the motivation to combine the references is due to impermissible hindsight based solely upon the present application.

Therefore, these claimed features in claim 1 would not be obvious to one of ordinary skill in the art. Claim 2 has been canceled. Accordingly, applicant respectfully requests that the rejections of claims 1 and 2 under 35 U.S.C. § 103(a) be withdrawn.

Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shimizu and Miyata, as applied to claims 1 and 2 above, further in view of U.S. Patent No. 7,100,307 to Burke et al. (hereinafter “Burke”).

Applicant respectfully requests withdrawal of these rejections because the combination of the cited references fails to teach or suggest all of the features of the claims. Claim 3 depends from independent claim 1 and claim 4 has been canceled. As discussed above, Shimizu and Miyata, either alone or in combination, fail to teach or suggest all of the features of the claim 1. It is respectfully submitted that Burke does not cure the deficiencies

argued above. Accordingly, applicant requests that rejection of claims 3 and 4 under 35 U.S.C. §103(a) be withdrawn.

Applicant has added new claim 5 and respectfully submit that the references, alone or in combination, fail to disclose

A health shoe comprising:

cumulate layers including a layer of cup in sole layer (36), middle sole layer (34), high elasticity sponge layer (32), and cushion layer (30);

a plurality of rows of round-shaped seat holes (22), the round shaped seat holes (22) formed in a thickness direction of a bottom rubber sole (20), the rows formed in a width direction of the bottom rubber sole (20), and the rubber sole (20) formed at a lower part of said cushion layer (30);

metal balls (26) to be fixed in the plurality of round-shaped seat holes (22); and

a plurality of refraction line holes (40) formed in the width direction at a front of the bottom rubber sole (20), wherein each of the plurality of refraction line holes (40) is formed in between rows of round-shaped seat holes (22).

(Claim 5).

Accordingly, applicant submits that claim 5 is patentable over Shimizu, Miyata, and Burke.

CONCLUSION

In conclusion, applicant respectfully submits that in view of the arguments and amendment set forth herein, the applicable objections and rejections have been overcome. Applicant reserves all rights under the doctrine of equivalents.

Pursuant to 37 C.F.R. 1.136(a)(3), applicant hereby requests and authorizes the U.S. Patent and Trademark Office to (1) treat any concurrent or future reply that requires a petition for extension of time as incorporating a petition for extension of time for the appropriate length of time and (2) charge all required fees, including extension of time fees and fees under 37 C.F.R. 1.16 and 1.17, to Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: July 13, 2009

/Ryan W. Elliott/

Ryan W. Elliott
Reg. No. 60,156

1279 Oakmead Parkway
Sunnyvale, CA 94085-4040
(408) 720-8300